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| 09/422,339   | 10/21/1999  | THOMAS G. WOOLSTON   | 11092-012001                | 5419             |
| 20985  | 7590        | 11/01/2006           |                             |                  |
| FISH & RICHARDSON, PC<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | EXAMINER<br>GART, MATTHEW S |                  |
|  |             |                      | ART UNIT<br>3625            | PAPER NUMBER     |

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/422,339

Applicant(s)

WOOLSTON ET AL.

Examiner

Matthew S. Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/29/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

The drawings were received on 9/29/2006. These drawings are accepted by the Examiner.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 49-66 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter.**

Referring to claims 49-66. Claim 49 is directed to computer software, embodied in a tangible medium or in a propagated carrier signal or both. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in §101. Claims 50-66 are dependent upon claim 49.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-5, 10-27, 29-49 and 51-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagoner (U.S. Patent Application Publication 2006/0074792) in view of Montero (U.S. Patent No. 6,133,912).**

Referring to claim 1. Wagoner discloses an computer-implemented method for encouraging users of a computer network to access dynamic pricing information on the computer network, the method comprising:

- Distributing over the computer network to a first user of the computer network a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network (Wagoner: at least paragraph 0024, "...displaying one or more auction data for the one or more identified auctions in a scrolling ticker on a user terminal, the one or more auction data is a hypertext link to a first web page associated with the action data.");
- Receiving from the first user input identifying selected dynamic pricing information (Wagoner: at least paragraph 0101: "The program reads the text strings contained in the text file, and displays the text string contents in a scrolling ticker as a selectable hypertext link enabling access to a web page addressed by the associated URL."); and

- Communicating the dynamic pricing information selected by the first user to a second user for display at a modular computer program, executing on a computer system associated with the second user, that displays to the second user a stream of dynamic pricing information (Wagoner: at least 0103: "In another embodiment, the auction data may be displayed on a vehicle dealer terminal. The auction data may advantageously be stored on one or more storage mediums **108**. The vehicle dealer terminal is a terminal used by a vehicle dealer to access the Data Center system.").

Wagoner does not expressly disclose presenting to the first user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program. Montero discloses presenting to the first user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program (Montero: at least column 4, line 63 to column 5, line 12). Montero discloses a method wherein INFO servers continuously transmit information such as advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates and like, to form a sequence of information. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Wagoner to have included the teachings of Montero as discussed above in order to continuously

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display information without interfering with the display of selected data (Montero: at least column 3, lines 21-23).

Referring to claim 3. Wagoner further discloses a method comprising collecting dynamic pricing information from the computer network (Wagoner: at least paragraph 0024).

Referring to claim 4. Wagoner further discloses a method wherein the computer network comprises the Internet (Wagoner: at least paragraph 0049).

Referring to claim 5. Wagoner further discloses a method wherein the computer network comprises a virtual private network (Wagoner: at least paragraph 0024).

Referring to claim 10. Wagoner further discloses a method comprising causing the modular computer program to display the stream of dynamic pricing information collected from the computer network (Wagoner: at least paragraph 0024).

Referring to claim 11. Wagoner further discloses a method wherein the stream of dynamic pricing information that is displayed varies based on user input (Wagoner: at least paragraph 0024, "...identifying the one or more auctions that satisfy the one or more filtering parameters.").

Referring to claim 12. Wagoner further discloses a method wherein the stream of dynamic pricing information has a predetermined taxonomy, and wherein the user can selectively view different levels of the taxonomy (Wagoner: at least paragraph 0099).

Referring to claim 13. Wagoner further discloses a method wherein the interactive visual indication comprises a glyph (Wagoner: at least paragraph 0101: "The

program reads the text strings contained in the text file, and displays the text string contents in a scrolling ticker as a selectable hypertext link enabling access to a web page addressed by the associated URL.”).

Referring to claim 14. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method wherein the interactive visual indication comprises an interactive link to the user-attractive resource (Montero: at least column 4, line 63 to column 5, line 42)

Referring to claim 15. Wagoner in view of Montero discloses a method according to claim 14 as indicated supra. Montero further discloses a method wherein the interactive link comprises a uniform resource locator tag (Montero: at least column 5, lines 60 to column 6, line 6)

Referring to claims 16-19. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method wherein the user-attractive resource comprises advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates and like, to form a sequence of information (Montero: at least column 4, line 63 to column 5, line 12). Montero does not explicitly state that the advertisement (one of many user-attractive resources) type takes the form of a contest, a reward program or a coupon. However, the type of advertisement is claimed utilizing a “wherein clause” that does not relate back to or clarifies what is required by the claims. The wherein clauses of claims 16-19 merely states the result of a limitation in the claims and is therefore given little patentable weight. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d

*1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (Fed. Cir. 2001).*

Referring to claim 20. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method wherein the user-attractive resource comprises a multi-media presentation (Montero: at least column 4, line 63 to column 5, line 12).

Referring to claim 21. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method comprising providing a user with access to the user-attractive resource upon sensing that the user selected the interactive visual indication (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claim 22. Wagoner further discloses a method wherein the modular computer program displays dynamic pricing information in a ticker display format (Wagoner: at least paragraph 0024).

Referring to claim 23. Wagoner further discloses a method wherein a plurality of instances of the modular computer program are presented to a user concurrently (Wagoner: at least paragraph 0024).

Referring to claim 24. Wagoner in view of Montero discloses a method according to claim 23 as indicated supra. Montero further discloses a method wherein each of the plurality of instance of the modular computer program includes one or more associated visual indications of a user-attractive resource available on the computer network (Montero: at least column 4, line 63 to column 5, line 42).



Referring to claim 25. Wagoner in view of Montero discloses a method according to claim 24 as indicated supra. Montero further discloses a method wherein each of the one or more visual indicators can be the same as or different from the visual indications on other instances of the modular computer program (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claim 26. Wagoner in view of Montero discloses a method according to claim 24 as indicated supra. Montero further discloses a method wherein each of the one or more visual indicators can correspond to the same or different user-attractive resources as the visual indications on other instances of the modular computer program (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claims 27 and 29-47. The limitations of claims 27 and 29-47 closely parallel those of claims 1, 3-5 and 10-26. Claims 27 and 28-47 are rejected under the same rationale as set forth above in claims 1, 3-5 and 10-26.

Referring to claim 48. The limitations of claim 48 closely parallel those of claim 1. Claim 48 is rejected under the same rationale as set forth above in claim 1.

Referring to claims 49 and 51-66. The limitations of claims 49 and 51-55 closely parallel those of claims 1, 3-5 and 10-26. Claims 49 and 51-66 are rejected under the same rationale as set forth in claims 1, 3-5 and 10-26.

**Claims 2, 6-9, 28 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagoner (U.S. Patent Application Publication 2006/0074792) in view of Montero (U.S. Patent No. 6,133,912) in further view of Bowman-Amuah (U.S. Patent No. 6,697,824).**

Referring to claims 2, 28 and 50. Wagoner in view of Montero discloses a method, system and product according to independent claims 1, 27 and 49 as indicated supra. Neither Wagoner nor Montero disclose wherein the modular computer program comprises a Java-based applet. Bowman-Amuah discloses wherein a modular computer program comprises a Java-based applet (Bowman-Amuah: at least column 10, lines 12-21).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above in order to improve client side performance (Bowman-Amuah: at least column 10, lines 12-21).

Referring to claim 6. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Bowman-Amuah discloses a method comprising pushing a copy of a modular computer program to one or more users of the computer network (Bowman-Amuah: at least column 37, lines 15-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above

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in order to enable an enterprise to reach and provide value to their customer outside of the traditional interactions (Bowman-Amuah: at least column 37, lines 24-35).

Referring to claim 7. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Bowman-Amuah discloses wherein distributing a modular computer program comprises enabling users of the computer network to pull a copy of a modular computer program (Bowman-Amuah: at least column 74, lines 19-29).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above in order to enable an enterprise to reach and provide value to their customer outside of the traditional interactions (Bowman-Amuah: at least column 37, lines 24-35).

Referring to claims 8-9. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Bowman-Amuah discloses wherein distributing a modular computer program comprises sending the modular computer program to a user of the computer network through an electronic mail system and an instant messaging system (Bowman-Amuah: at least column 53, lines 27-35).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above in order to enable an enterprise to reach and provide value to their customer outside of the traditional interactions (Bowman-Amuah: at least column 37, lines 24-35).

***Response to Arguments***

Applicant's argument with respect to claims 49-66 as being directed towards non-statutory subject matter has been considered but is not persuasive. Applicant cites 2106 (IV)(B)(1)(c) as a showing that electromagnetic signals have physical properties and thus should be eligible as an article of manufacture.

The Examiner notes, the propagated carrier signal of claim 49 is not in positive combination with a physical statutory structure (the tangible medium) and therefore no useful, concrete and tangible result is accomplished.

The Applicant argues that Wagoner fails to disclose or suggest distributing to a first user, a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network.

The Examiner notes, Wagoner discloses a method wherein a scrolling ticker is displayed to a user. The user may specify one or more parameters that can be used in filtering the content of the scrolling ticker (Wagoner: paragraph 0102). Wagoner further teaches that the scrolling ticker may advantageously be implemented utilizing the freeware program "ticker.class" (Wagoner: paragraph 0101).

The term "distributing" in the independent claims is defined by using its common meaning as understood by a person of experience in the field of the invention. Dictionary.com (<http://dictionary.reference.com/browse/distributing>) defines "distributing" as the act of delivering or passing out. In view of Dictionary.com, the act of displaying content to a user in Wagoner is functionally equivalent to the distribution of information

in the instant invention.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.” In re Hyatt, 211 F.3d1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

The Applicant argues that Wagoner fails to disclose communicating the dynamic pricing information selected by the first user to a second user for display at a modular computer program.

The Examiner notes, Wagoner discloses a method wherein auction data may be displayed on a vehicle dealer terminal (i.e., second user). The vehicle dealer terminal is a terminal used by a vehicle dealer to access the Data Center system. Wagoner further teaches that the vehicle dealer may be a seller or a potential bidder in the online product auction system. Having accessed the Data Center system, the Data Center system can display on the vehicle dealer terminal a scrolling ticker containing information regarding the one or more vehicle auctions contained in the auction center (i.e., dynamic pricing information).

The Applicant argues that the office action must provide a motivation for combining the multiple embodiments of Wagoner.

The Examiner notes, the embodiments in Wagoner are not used to describe independent or distinct inventions, but merely are used to provide working examples of a single inventive concept. Furthermore, the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

The Applicant argues that Montero does not disclose provide an incentive, independent of the dynamic pricing information, to use the modular computer program as recited in claim 1.

The Examiner notes, advertisements, news, messages, etc., are user-attractive resources and are independent of the dynamic pricing information (i.e., stock ticker).

The Applicant argues that Montero fails to provide a modular program.

The Examiner notes, Wagoner discloses a modular program. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant argues that the Java Applet of Bowman-Amuah is not capable of

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receiving dynamic pricing information, displaying the received dynamic pricing information, receiving from the first user information, sending the received selection information, and presenting to the second user as recited in claims 1-2, 27-28, and 49-50.

The Examiner notes, Bowman-Amuah explicitly discloses that with Java, developers can create robust User Interface (UI) components. Custom "widgets" (e.g., real-time stock tickers, animated icons, etc.) can be created, and client-side performance is improved. Unlike HTML, Java supports the notion of client-side validation, offloading appropriate processing onto the client for improved performance. Dynamic, real-time Web pages can be created. Using the above-mentioned custom UI components, dynamic Web pages can also be created (Bowman-Amuah: column 10, lines 12-21).

Furthermore, if the functionally-defined disclosed means and their equivalents of the instant invention are so broad that they encompass any and every means for performing the recited functions . . . the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions "); In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971)

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG

Primary Examiner

October 29, 2006



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